

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARION SCOTT BRIGHT, PUSHPALATHA CHANNIKERE,
BALASUBRAMANIAN GOPALAN, RAHUL JINDANI, JINRAJ DHROVAKUMAR
JOSHIPURA, VINOD KANNOTH, JAYAKUMAR KRISHNAMURTHY, GREGORY LEE
MCKEE, SYLVAIN MICHEL, PENNY JEANNETTE PEACHEY-KOUNTZ
and JAMES DONALD SCOTT

Appeal No. 2003-0901
Application 09/303,368

HEARD: JULY 14, 2004

Before HAIRSTON, JERRY SMITH and FLEMING, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 3, 4, 6, 8, 9, 11 and 13-24, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for pre-processing electronic sales order data before it is transmitted to an order processing system.

Representative claim 1 is reproduced as follows:

1. A system for pre-processing orders before they are transmitted to an order processing system, comprising:

an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system;

an interface system receiving the electronic sales order data from the order interceptor and performing an availability check, wherein the availability check determines the portions of the electronic sales order data that can be satisfied; and

means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing.

The examiner relies on the following references:

Johnson et al. (Johnson)	6,023,683	Feb. 08, 2000 (filed Aug. 10, 1994)
Blinn et al. (Blinn)	6,058,373	May 02, 2000 (filed Oct. 16, 1996)

Claims 1, 3, 4, 6, 8, 9, 11 and 13-24 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Blinn taken alone or Johnson taken alone.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

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modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this

decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

We consider first the rejection of all pending claims based on the teachings of Blinn. The examiner finds that Blinn teaches the claimed invention except that Blinn does not teach two separate processing systems, that is, a pre-processing system and a processing system. The examiner finds that it would have been obvious to the artisan to modify the integrated Blinn system so as to split the processing disclosed therein into two separate processing systems as claimed [answer, pages 4-5].

Appellants argue that their invention relates to an integrated system for pre-processing Electronic Sales Orders (ESOs) or Electronic Purchase Orders (EPOs) in order to validate certain criteria before routing the same, altered, or additional ESOs or EPOs to an order processing system. Appellants assert that the claimed pre-processing is meant to act upon an entire order before the actual subsequent order placement. Appellants note that their invention amounts to much more than splitting the processing into pre-processing and processing. Appellants argue that Blinn has no disclosure of pre-processing orders as defined in the present invention. Appellants note that the claimed pre-

processing occurs prior to any ESO being routed by a router to an order processing system [brief, pages 5-8].

With respect to independent claim 1, the examiner points out in detail how he reads the claimed invention on Blinn. The examiner notes that Blinn essentially anticipates the claimed invention except for the fact that the examiner has interpreted the claimed invention as requiring separate systems for the pre-processing and for the processing. The examiner finds that Blinn teaches all the functions of the claimed invention except that the pre-processing and processing of Blinn are integrated into a single device. The examiner responds that the pre-processing steps of Blinn are performed before the processing steps and before any actual order placement [answer, pages 6-10].

Appellants respond that the present invention is meant for intercepting an already completed purchase order between two trading partners and then pre-processing the completed purchase order before re-submitting the order to an appropriate order fulfillment system. Appellants argue that Blinn does not perform what is termed pre-processing by the present invention. Appellants argue that the "pre-processing" in Blinn occurs before the purchase order is completed so that it is not pre-processing as intended by the claimed invention [reply brief, pages 4-7].

We will sustain the examiner's rejection of independent claim 1 based on the teachings of Blinn. The thrust of appellants' arguments is that the "pre-processing" of the claimed invention refers to pre-processing of completed purchase orders which is different than the pre-processing of Blinn identified by the examiner. We do not agree with appellants' arguments. During prosecution before the examiner, claims are given their broadest reasonable interpretation. This is done because an applicant has an opportunity at this time to amend the claims so that they accurately reflect what the applicant is trying to protect. The examiner has read the pre-processing of claim 1 on the processing in Blinn which takes place before the final processing of the order is confirmed. We agree with the examiner that these operations of Blinn, such as item availability, can be considered to fall within the broad term of pre-processing in claim 1. We also agree with the examiner that it would have been obvious to the artisan to separate the pre-processing operations and the processing operations of Blinn into separate processing devices as explained by the examiner. We note, however, that we do not agree with the examiner's position that the claimed pre-processing and processing must be interpreted to include separate devices for performing the pre-processing and the processing. We

do not find any basis which compels reading two devices into the invention of claim 1.

Appellants indicate that the claims stand or fall together as a single group [brief, page 5]. Nevertheless, appellants refer to the limitations of several other claims on page 8 of the brief. Since this portion of the brief does nothing more than recite the limitations of other claims on appeal and make a general assertion that Blinn does not teach or suggest these limitations, we find that this portion of the brief does not constitute a valid separate argument for patentability. Therefore, all the other claims on appeal fall with claim 1 for reasons discussed above.

We now consider the rejection of all pending claims based on the teachings of Johnson. The examiner finds that Johnson teaches the claimed invention except that Johnson does not teach two separate processing systems, that is, a pre-processing system and a processing system. The examiner finds that it would have been obvious to the artisan to modify the integrated Johnson system so as to split the processing disclosed therein into two separate processing systems as claimed [answer, page 5].

Appellants' arguments with respect to this rejection essentially parallel the arguments discussed above with respect to the rejection based on Blinn. The examiner's response to appellants' arguments and appellants' arguments set forth in the reply brief are essentially the same as the arguments we considered above.

We will sustain the examiner's rejection of claim 1 based on the teachings of Johnson for reasons discussed above. Specifically, the key question again is appellants' improper attempt to have the term "pre-processing" of claim 1 interpreted in a manner which is narrower than its broadest reasonable interpretation. We agree with the examiner that the processing of Johnson which he has identified as pre-processing is consistent with the broadest reasonable interpretation of that term.

Once again, although appellants refer to other claims on appeal, the discussion of these other claims does not amount to a separate argument for patentability. Therefore, we also sustain the examiner's rejection of all the other claims on appeal based on Johnson.

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In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 3, 4, 6, 8, 9, 11 and 13-24 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


KENNETH W. HAIRSTON
Administrative Patent Judge)
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JERRY SMITH
Administrative Patent Judge)
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MICHAEL R. FLEMING
Administrative Patent Judge)
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